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09/597,150	06/20/2000	Takehiro Yoshida	35.C14560	5109

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EXAMINER

DUONG, FRANK

ART UNIT PAPER NUMBER

2666

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/597,150

Applicant(s)

YOSHIDA ET AL.

Examiner

Frank Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is a response to the amendment dated 2/12/04. Claims 1-27 are pending in the application.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed 3/30/04 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been considered and placed in the application file.

#### ***Drawings***

The drawings were received on 2/13/04. These drawings are approved.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Nozawa et al (USP 5,668,640) (hereinafter "Nozawa").

Regarding **claim 1**, in accordance with Nozawa reference entirety, Nozawa discloses a communication apparatus (FIG. 1) comprising:

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a multi-address transmission unit (FIG. 1; element 15 or FIG. 3) which is adapted to execute a ring type multi-address transmission (circular transmission) in a group of communication apparatuses (*col. 11, lines 7-14*); and

a determination unit (FIG. 1; element 3), which is adapted to make a determination as to whether a ring type multi-address transmission is specified (*col. 11, lines 20-27 and thereafter*),

wherein, when the ring type multi-address transmission (*circulation transmission*) is specified, said multi-address transmission unit memory-receives data received by communication apparatus (*document data stored in the image memory 4*) (*col. 11, lines 3-7*), and transmits the memory-received data to a next station (*members A, B, G and H of group members A, B, E, G, H and I*) (*col. 11, lines 47-49*) based on a print-out instruction issued according to a manual actuation of an operator (*col. 11, lines 14-27, Nozawa discloses in circular transmission, the user directly presses the corresponding region of the display part 61 provided with the touch sensor panel to sequentially specify desired ones of the members in the displayed list in its circulation order*).

Regarding **claim 2**, in addition to features recited in base claim 1 (see rationales discussed above), Nozawa further discloses wherein said multi-address transmission unit (FIG. 1) transmits the memory-received data to the next station based on a specification from the operator (*col. 11, lines 14-15 and thereafter*).

Regarding **claim 3**, in addition to features recited in base claim 1 or 2 (see rationales discussed above), Nozawa further discloses wherein said multi-address

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transmission unit (*FIG. 1*) transmits the memory-received data to the next station after the data is printed out, based on a specification from the operator (*col. 9, lines 58-60*).

Regarding **claim 4**, in addition to features recited in any one of base claims 1 to 2 (see rationales discussed above), Nozawa further discloses wherein said multi-address transmission unit includes a selection unit (*FIG. 12 or 14-16; element 61 or 62*), which selects, based on a specification from the operator, transmission of the memory-received data to the next station or transmission of the memory received data to the next station after the data is printed out (*col. 9, lines 58-60*).

Regarding **claim 5**, in accordance with Nozawa reference entirety, Nozawa discloses a communication apparatus (*FIG. 1*) designed to perform a ring type multi-address transmission (circular transmission) by transferring received data (*document stored in image memory 4*) to a next station (*members A, B, G and H of group members A, B, E, G, H and I*) comprising:

a receiving unit (*FIG. 1; element 2*) which is adapted to receive data sent by type a multi-address transmission (*col. 15, lines 32-53 and thereafter*); and

an instruction unit (*FIG. 1; element 3*), which is adapted to issue an instruction on a transfer of the received data to the next station (*col. 13, lines 9-25 and thereafter*); and

a transferring unit (*FIG. 1; element 3*), which is adapted to transfer the received data to the next station if the transfer to the next station is selected based on the instruction by said instruction unit (*col. 13, lines 9-25 and thereafter*),

wherein said transferring unit forcibly transfers the received data to the next station if the instruction by said instruction unit is not issued within a predetermined period of time (*col. 13, lines 54-65*).

Regarding **claim 6**, in addition to features recited in base claim 5 (see rationales discussed above), Nozawa further discloses a displace unit (*FIG. 1; element 6*), which is adapted to display a presence or an absence of the received data (*FIG. 5; element 611*) (*col. 8, lines 63-67*); a storing unit (*FIG. 1; element 4*), which is adapted to store the received data (*col. 12, lines 43-53*); and a printing unit (*FIG. 1; element 11*), which is adapted to print the stored data (*col. 14, lines 45-48*), wherein, if data sent by a multi-address transmission is received, said storing unit stores a time (*attribute*) of reception thereof (*col. 12, lines 54-59*), and said displaying units displays the presence of the received data (*col. 14, lines 37-40*), and said printing unit forcibly prints the received data if the instruction by said instruction unit is not issued within a specified period of time (*col. 14, lines 44-48*).

Regarding **claim 7**, in addition to features recited in base claim 5 or 6 (see rationales discussed above), Nozawa further discloses a starting unit (*FIG. 8; 61 or 616*), which is adapted to start a multi-address transmission (circulation transmission); and a registration unit (*FIG. 10; 61 or Destination List*), which is adapted to register data regarding the next station (*col. 11, lines 7-51*).

Regarding **claim 8**, in addition to features recited in base claim 6 (see rationales discussed above), Nozawa further discloses an erasing unit (*FIG. 5; element 4 and 5* and "erase command", which is adapted to erase the received data from said storing

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unit if transfer of the received data is normally finished (*col. 6, line 63 to col. 7, line 15 and thereafter*).

Regarding **claim 9**, in addition to features recited in any one of base claims 6 and 8 (see rationales discussed above), Nozawa further discloses wherein said printing unit prints a reception of the received data sent by the multi-address transmission (*col. 8, lines 58-64*) and a transfer of the received data to the next station when forcibly printing the received data (*col. 13, lines 54-65*).

Regarding **claim 10**, in accordance with Nozawa reference entirety, Nozawa discloses a communication method (FIG. 1) comprising the steps of:

executing a ring type multi-address transmission (circular transmission) (FIG. 1; element 15 or FIG. 3) in a group of communication apparatuses (*col. 11, lines 7-14*); and

making a determination (FIG. 1; element 3 as to whether a ring type multi-address transmission is specified (*col. 11, lines 20-27 and thereafter*),

wherein, when the ring type multi-address transmission (circulation transmission) is specified, said multi-address transmission step includes memory-receiving data (*document data stored in the image memory 4*) (*col. 11, lines 3-7*), and transmitting the memory-received data to a next station (*members A, B, G and H of group members A, B, E, G, H and I*) (*col. 11, lines 47-49*) based on a print-out instruction issued according to a manual actuation of an operator (*col. 11, lines 14-27, Nozawa discloses in circular transmission, the user directly presses the corresponding region of the display part 61*

*provided with the touch sensor panel to sequentially specify desired ones of the members in the displayed list in its circulation order).*

Regarding **claim 11**, in addition to features recited in base claim 10 (see rationales discussed above), Nozawa further discloses wherein said step of executing a ring type multi-address transmission (FIG. 1) includes transmitting the memory-received data to the next station based on a specification from the operator (*col. 11, lines 14-15 and thereafter*).

Regarding **claim 12**, in addition to features recited in base claim 10 or 11 (see rationales discussed above), Nozawa further discloses wherein said step of executing a ring type multi-address transmission (*FIG. 1*) includes transmitting the memory-received data to the next station after the data is printed out, based on a specification from the operator (*col. 9, lines 58-60*).

Regarding **claim 13**, in addition to features recited in any one of base claims 10 to 11 (see rationales discussed above), Nozawa further discloses wherein said step of executing multi-address transmission includes a selection step of selecting (*FIG. 12 or 14-16; element 61 or 62*), based on a specification from the operator, transmission of the memory-received data to the next station or transmission of the memory received data to the next station after the data is printed out (*col. 9, lines 58-60*).

Regarding **claim 14**, in accordance with Nozawa reference entirety, Nozawa discloses a communication method (FIG. 1) designed to perform a ring type multi-address transmission (circular transmission) by transferring received data (*document*



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stored in image memory 4) to a next station (*members A, B, G and H of group members A, B, E, G, H and I*) comprising the steps of:

receiving (*FIG. 1; element 2*) data sent by type a multi-address transmission (*col. 15, lines 32-53 and thereafter*);

issuing an instruction unit (*FIG. 1; element 3*) on a transfer of the received data to the next station (*col. 13, lines 9-25 and thereafter*); and

transferring (*FIG. 1; element 3*) the received data to the next station if the transfer to the next station is selected based on the instruction (*col. 13, lines 9-25 and thereafter*),

wherein said transferring step includes forcibly transferring the received data to the next station if the instruction by said instruction unit is not issued within a predetermined period of time (*col. 13, lines 54-65*).

Regarding **claim 15**, in addition to features recited in base claim 14 (see rationales discussed above), Nozawa further discloses displaying (*FIG. 1; element 6*), a presence or an absence of the received data (*FIG. 5; element 611*) (*col. 8, lines 63-67*); storing (*FIG. 1; element 4*) the received data (*col. 12, lines 43-53*); and printing (*FIG. 1; element 11*) the stored data (*col. 14, lines 45-48*), wherein, if data sent by a multi-address transmission is received, said storing step includes storing a time (*attribute*) of reception thereof (*col. 12, lines 54-59*), and the presence of the received data is displayed in said display step (*col. 14, lines 37-40*), and said printing step includes forcibly printing the received data if the instruction is not issued within a specified period of time (*col. 14, lines 44-48*).

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Regarding **claim 16**, in addition to features recited in base claim 14 or 15 (see rationales discussed above), Nozawa further discloses starting (*FIG. 8; 61 or 616*) a multi-address transmission (circulation transmission); and registering (*FIG. 10; 61 or Destination List*) data regarding the next station (*col. 11, lines 7-51*).

Regarding **claim 17**, in addition to features recited in base claim 15 (see rationales discussed above), Nozawa further discloses erasing (*FIG. 5; element 4 and 5* and "erase command" the received data in said storing step if transfer of the received data is normally finished (*col. 6, line 63 to col. 7, line 15 and thereafter*).

Regarding **claim 18**, in addition to features recited in any one of base claims 15 and 17 (see rationales discussed above), Nozawa further discloses wherein said printing step includes printing a reception of the received data sent by the multi-address transmission (*col. 8, lines 58-64*) and a transfer of the received data to the next station when forcibly printing the received data (*col. 13, lines 54-65*).

Regarding **claims 19-22**, the claims are rejected by the same rationales applied to claims 10-13 discussed above.

Regarding **claims 23-27**, the claims are rejected by the same rationales applied to claims 14-18 discussed above.

### ***Response to Arguments***

4. Applicant's arguments filed 2/12/04 have been fully considered but they are not persuasive. Applicants' arguments will be addressed hereinbelow in the order in which they appear in the response filed 2/12/1004.

In the Remarks of the outstanding response, on 15, pertaining the rejection of claim 1, Applicants state *"One of the notable features of Claim 1 is that the memory-received data is transmitted to the next station based on the issuance of the print-out instruction by a manual actuation of the operator"* and argue *"Nozawa et al. relates to a facsimile apparatus that receives document data from another facsimile apparatus and stores the received data in an image memory. As understood by Applicants, Nozawa et al. teaches that the received data may be transmitted to another facsimile apparatus without having to print the data and then reading the printed document"*.

In response Examiner respectfully disagrees and contends the Office Action does clearly pointed out the claimed invention corresponding to the Nozawa reference. In the Field of the Invention at col. 1, lines 9-17, Nozawa clearly states *"every data received documents are once stored in an image memory enabling to display a desired part of the document in a display unit for confirmation of its contents"*. Moreover, the claimed limitation, which Applicants asserted novel, *"the memory-received data is transmitted to the next station based on the issuance of the print-out instruction by a manual actuation of the operator"* is equated to correspond to *"circular transmission command"* issued by a user disclosed at col. 11, lines 7-8 and thereafter. Contradistinction to the Applicants' assertion, Nozawa discloses the claimed invention in the present condition.

In the Remarks of the outstanding response, on page 16, Applicants further state *"As understood from Fig. 7B of Nozawa et al., data received through a ring type multi-address transmission is transmitted to a next station irrespective of whether an operator*

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*confirms the data. Therefore, Nozawa et al. fails to provide the beneficial feature of Claim 1 discussed above, in which an operator is able to securely confirm receipt of data received through a ring type multi-address transmission".*

In response Examiner respectfully disagrees for the following rationales.

First, a careful review the disputed claim 1, Examiner finds no such language of *"data received through a ring type multi-address transmission is transmitted to a next station irrespective of whether an operator confirms the data" and "provide the beneficial feature of Claim 1 discussed above, in which an operator is able to securely confirm receipt of data received through a ring type multi-address transmission"* in the claim. Perhaps Applicants refer to certain features that are disclosed in the present application but not recited in the rejected claims in making the contention that the Nozawa reference fails to show certain feature of Applicants' invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, the command for confirmation of the received message is depicted in FIG. 15; element 622.

Second, for the sake of argument, let's say the argued limitations are in the claimed invention, Nozawa describes the confirmation of messages as depicted in FIG. 15; element 15. The description thereat still reads on the argued limitations.

On page 17 of the response, Applicants allege the Nozawa reference fails to teach the Applicants' deemed novel features of claims 5 as *"One of the notable features of Claim 5 is that data received in a ring type multi-address communication is forcibly*

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*transferred to a next station if an instruction to transfer the received data is not issued within a predetermined time period. By virtue of this feature, when an operator is not present for an extended period of time, for example, and thus cannot issue an instruction to transfer the received data, the received data can still be transferred via a ring type multi-address transmission without an indefinitely long interruption".*

In response Examiner respectfully disagrees and contends the Office Action has clearly pointed out the claimed limitations corresponding to the Nozawa reference. The argued limitation, Applicants asserted novel, sounds just like a regular function in a "circular transmission"-capable fax machine. Moreover, "forcibly transmitting" something is not a unique feature. Contradistinction to the Applicants' arguments, Nozawa's fax machine does clearly anticipated the claimed invention in the present condition.

Examiner believes an earnest attempt has been made in addressing all of the Applicants' arguments. Due to the arguments are not persuasive and the Nozawa reference still anticipated the claimed inventions in a present condition, the rejection from last Office Action is maintained.

### **Conclusion**

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is (703) 308-5428. The examiner can normally be reached on 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (703) 308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Frank Duong', with a stylized, cursive script.

Frank Duong  
Examiner  
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April 27, 2004